

Appl. No.: 09/653,384  
Amdt. Dated: July 6, 2007  
Reply of Office action of March 7, 2007

Docket No. SHOL-0587

### **REMARKS**

Claims 42-51, 53-61, 63, and 64 are currently pending in the application. Applicant has canceled independent claims 39 and 62 and added new independent claims 63 and 64. Applicant has amended claims 42, 43, 45, 47, 49, 50, 53, 54, 56, and 58-61 to change the dependency from independent claim 39 (canceled) to independent claim 63 (new). Applicant requests reconsideration of the application in light of the following remarks.

It is noted that in the Office Action Summary on page 1 of the last Office Action, the status is listed as non-final. Applicant is assuming that the form paragraph on page 14 of the last Office Action is a typographical error.

### **Rejections under 35 U.S.C. §112**

Claims 39, 42-51 and 53-62 stand rejected by the Examiner under 35 U.S.C. 112, first and second paragraphs. In accordance with this rejection, independent claims 39 and 62 have been canceled in order to advance prosecution. New independent claims 63 and 64 have been added in order to comply with the Examiner's suggestions and are now believed to conform to Section 112, first and second paragraphs. Applicant respectfully requests that the rejection of claims 42-51 and 53-61 under 35 U.S.C. § 112 be withdrawn.

Independent claims 63 (new) and 64 (new) recite “generating an indication of when the patient is accepted as a new patient based in part on the net present value and the rank assigned to the patient’s TPP “and “generating an indication of when the patient’s requested appointment should be scheduled based in part on the net present value and the rank assigned to the patient’s TPP.“ The scheduling is of “the patient’s requested appointment” not “the **new** patient’s requested appointment.” The rank is assigned to “the patient” not “the

**new** patient.” Therefore, a particular ranking will be result in “the patient” not accepted as a “new patient” and the same ranking will result in when the patient’s requested appointment will be scheduled, regardless of whether the patient is accepted as a **new** patient or not. The rank is still part of the data set.

“As should be clear to one of ordinary skill in the art, though readily determinable using well known equations, ... for any specific time and medical service will vary because the specific characteristics of each service provider are different, and the relevant factors in a relative value calculation may vary over time.” See page 16, lines 19-24 of Applicant’s disclosure.

Assigning a rank, as recited in new independent claims 63 and 64 finds support throughout Applicant’s disclosure, particularly on page 18, line s 13- 16, “when considering to accept a new patient, data relevant to the patient’s TPP is reviewed and evaluated, and the TPP is assigned a rank, grade or other indicator to indicate to those considering whether to accept the new patient an estimated relative value of the likely services for the patient.”

Applicant discloses on page 20, lines 1-3, “the relative value of the medical services to be provided for a patient is calculated and considered as a factor in a determination of scheduling the patient for his appointment.” A rank is generated and the rank is used by a scheduling employee (page 20, line 6). The relative value of a requested medical service (page 21, line 3) is used to determine the duration of a patient’s appointment. Of course, the requested service may vary from the actual service but the determination is done nonetheless.

For example, when a ranking style of colors is used, it may be determined that for blue indicators, appointments are never scheduled and for red indicators the appointments should be scheduled at least one month away. Emergency appointments are seen in the traditional as soon as possible manner, as disclosed on page 20, lines 20-21 of Applicant’s disclosure. The physician can also adjust the actual time spent with a patient as required for a particular patient (page 22, lines 5-6).

Appl. No.: 09/653,384  
Amdt. Dated: July 6, 2007  
Reply of Office action of March 7, 2007

Docket No. SHOL-0587

Independent claims 63 (new) and 64 (new) recite “generating an indication of the net present value of the at least one requested medical service prior to providing the medical service.” The requested (or potential or likely) medical service is used for generating data. Whether or not the requested medical service is performed is irrelevant to the claim language in step 5) of independent claim 63 (new) and independent claim 64 (new).

For the purpose of applying prior art, the Examiner must read independent claim 63 (new) to require generating an indication of when to schedule an appointment. Further, for the purposes of applying prior art, the Examiner must read independent claim 64 (new) to require generating an indication of appointment duration. Hence, contrary to the Examiner’s arguments, step 5) is always performed, whether or not the patient is accepted as a new patient.

### **Rejections under 35 U.S.C. §103**

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants’ disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims 39, 42-51 and 53-62 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,456,983 to Keyes et al. (Keyes) in view of U.S. Patent No. 6,044,351 to Jones (Jones) and U.S. Patent No. 5,924,074 to Evans (Evans). Applicant respectfully traverses this rejection and requests reconsideration of the claims.

Keyes teaches a system and method for evaluating an offer made in relation to certain delinquent accounts, and more specifically to charge accounts. The system has two components, a historical portfolio module and an evaluation module that is operated by a computer. The historical portfolio module is used to retrieve an appropriate collection of historical data based upon analysis to be conducted on certain currently delinquent accounts, identify a basis for dividing the retrieved collection of historical data into a plurality of groups, and obtain information on the payment history for each group. The evaluation module can then process the information from the historical portfolio and make a recommendation on the disposition of the currently delinquent accounts being analyzed. A NPV is calculated and the preferred system calculates three separate NPVs and compares them to determine the disposition of the delinquent accounts, i.e. whether to accept an offer or not. (See col. 4, line 42 - col. 5, line 10 and col. 9, line 39 - col. 10, line 19).

There is no disclosure anywhere in Keyes to “generating an indication of when a patient is accepted as a new patient based in part on the net present value” and “the rank assigned to the patient’s TPP,” as recited in independent claims 63 (new) and 64 (new). Further, there is no disclosure of “generating an indication of when the patient’s requested appointment should be scheduled, based in part on the net present value” and “the rank assigned to the patient’s TPP,” as recited in independent claims 63 (new) and 64 (new). Still further, there is no disclosure in Keyes to “wherein the software is configured to generate a recommended duration for a primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers,” as recited in dependent claim 54 (currently amended) and independent claim 64 (new).

The claims as written, now recite assigning a rank. The rank is a factor in whether to accept the patient as a new patient. The same rank is a factor in scheduling and duration. All of the patients are in the database, accepted as a new patient or not and all of the patients are

considered for scheduling and duration. If the rank is such to not accept the patient as a new patient then the rank would also be such to not schedule the patient's appointment for any duration.

As discussed supra, step 5) of independent claim 63 (new) and independent claim 64 (new) is performed whether or not the patient is accepted as a new patient. Note, both independent claims 63 (new) and 64 (new) recite generating an indication of when the patient's requested appointment should be scheduled, not generating when the **new** patient's requested appointment should be scheduled. The assigned rank is part of the data set and is, for example, a number, a color or a letter. If the number, or letter or color is such that the patient is not accepted as a new patient, then the number or letter or color would be such that the indication would be to not schedule an appointment for any duration.

Jones and Evans fail to overcome the deficiencies of the primary reference, Keyes. Jones is a computer software program that predicts the probability distribution of health care facility future minimum income for a total time interval consisting of equal sized time sub-intervals. This information provides physicians with information to be able to compare costs and worst case scenario future income. (See col. 2, lines 9-30).

Evans is a medical records system that is used to create and maintain patient data electronically. As part of the system health care provider has the ability to schedule an appointment using a point and click interface. There is no disclosure in either Jones or Evans as to net present value, let alone using net present value as a factor for accepting patients and/or scheduling appointments, as recited in independent claims 63 (new) and 64 (new). Again, as with Keyes, there is no disclosure in either Jones or Evans to "wherein the software is configured to generate a recommended duration for a primary medical personnel

to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers,” as recited in dependent claim 54 (currently amended) and independent claim 64 (new).

Claims 54-55 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,456,983 to Keyes et al.(Keyes) in view of U.S. Patent No. 6,044,351 to Jones (Jones) and U.S. Patent No. 5,924,074 to Evans (Evans), as applied to claim 39, and further in view of U.S. Patent No. 5,845,253 to Rensimer et al. (Rensimer). Applicant respectfully traverses this rejection and requests reconsideration of the claims.

Rensimer discloses a system and method for processing patient data. An objective measure of a physician’s rendered level of care, as described by a clinical status code, is automatically generated. One of the data elements used in this determination is a time influence factor. The time influence factor refers to an adjustment to the Physician’s Current Procedural Terminology Manual (CPT) standard amount of time associated with a clinical status code.

Rensimer fails to overcome the deficiencies of Keyes, Jones and Evans. As in all of the references relied on supra, there is no disclosure in Rensimer to “generating an indication of when a patient is accepted as a new patient based in part on the net present value;” as recited in independent claims 63 (new), from which claim 54 (currently amended) depends, and 64 (new). Further, there is no disclosure of “generating an indication of when the patient’s requested appointment should be scheduled, based in part on the net present value,” as recited in independent claims 63 (new), from which claim 54 (currently amended) depends, and 64 (new). Still further, there is no disclosure in Rensimer to a “third party payor (“TPP”),” let alone to “wherein the software is configured to generate a recommended

Appl. No.: 09/653,384  
Amdt. Dated: July 6, 2007  
Reply of Office action of March 7, 2007

Docket No. SHOL-0587

duration for a primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers,” as recited in dependent claim 54 (previously presented) and independent claim 64 (new). The time influence factor of Rensimer has nothing to do with cost.

It is difficult, if not impossible, to imagine how one skilled in the art in possession of all these references could conceive of the present invention absent hindsight reconstruction which was prohibited by the Supreme Court in *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428 435-436 (1911). To find obviousness, “there must be some reason for the combination other than the hindsight gleaned from the invention itself.” *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). Stated in another way, “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch* 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Applicant respectfully submits that the combination of the Keyes, Jones, Evans, and Rensimer patents for the purposes of the present rejection is improper because of the failure of any patent to suggest the combination. It is a requirement that in making a combination of patents in a rejection, those patents must suggest the desirability of the combination of teachings. This requirement was expressed by the Court of Customs and Patent Appeals in In re Imperato, 179 U.S.P.Q. 730 where it stated:

“...the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination.”

Appl. No.: 09/653,384  
Amdt. Dated: July 6, 2007  
Reply of Office action of March 7, 2007

Docket No. SHOL-0587

Since the cited references are devoid of any teaching as to the desirability of the combination, it is submitted that the rejection based on the combination is therefore untenable. Therefore, without a teaching or suggestion of the desirability of the combination, the rejection could have only been made upon a hindsight reconstruction from the teaching of Applicant's own disclosure.

There is no motivation to combine the teachings of the references relied on by the Examiner. As set forth above, none of the references even remotely disclose patient scheduling and appointment duration. Keyes, the primary reference, is related to a method of managing delinquent accounts and is non-analogous art. Jones is related to a computer program for health care facilities. Evans is related to an electronic medical records system for patient data and Rensimer is related to on-going physician care. Applicant respectfully requests that the obviousness rejections of claims 42-51 and 53-61 be withdrawn.

Given the foregoing shortcomings of Keyes, Jones, Evans, and Rensimer, it is respectfully submitted that the references fail to disclose or suggest the invention of claims 42-51, 53-61, 63, and 64. Accordingly, withdrawal of the rejections under 35 U.S.C. §112 and 35 U.S.C. §103(a) is respectfully requested.

It is respectfully submitted that the present claims describe a medical management system that meets the requirements of patentability. Applicant therefore respectfully requests that a timely Notice of Allowance be issued in this case.



Appl. No.: 09/653,384  
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Docket No. SHOL-0587

**Regarding Doctrine of Equivalents**

Applicant hereby declares that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

**CONCLUSION**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

It is requested that a one-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$60 to be charged to Deposit Account No. 19-0513.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The Examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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